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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,217	12/15/2003	Carl Young	3499-256	7693

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/737,217

Applicant(s)

YOUNG ET AL.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10, 11-3 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to Claims 1, 15, 16 and 17: the phrase “selection of an element” is indefinite. Previously the claims recite a relationship between two or more elements and receiving an indication of a security risk associated with one or more of the elements. It is unclear to the examiner if “an element” in this phrase is referring to the elements in the hierarchical relationship, if it is the element that has a security risk associated with it, or if this is a different element all together.

4. Claim 3 recites the limitation "the element" in line 1. There is insufficient antecedent basis for this limitation in the claim. Is this the element that is selected, one that is indicated as having a security risk or one that has a hierarchical relationship?

5. With respect to Claim 11: the phrase “presenting a graphical user interface related to a facility and comprising one or more images of the facility” is indefinite. A graphical user interface is an interface that is capable of displaying graphics and allows interaction with a user, similar to a computer screen. An interface can display images that relate to a facility and can display one or more images. However it is unclear to the examiner how a computer screen can be related to a facility and how a computer screen can comprise an image.

Claim Rejections - 35 USC § 101

Claims 1-10, and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis for this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

In the present case, claims 1-10 and 14 only recite an abstract idea. The recited steps of merely setting a hierarchical relationship, receiving an indication of a security risk and transmitting a description of the security risk, does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pen and paper. These steps only constitute an idea of how to manage a security risk.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise

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abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "computer implemented". Looking at the claim as a whole, nothing the body of the claim recites any structure of functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces the result of identifying security risks of an entity (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-10 and 14 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Beverina et al. (US 2001/0027388).

8. With respect to Claims 1, 15, 16: Beverina discloses the use of a computer system with a computer implemented method for managing security risks (see abstract) which uses a computer executable code (paragraph 0011) to perform the following steps:

- a. Setting a hierarchical relationship between two or more elements (See Figures 8 and 15, paragraphs 0015, 0078, 0079 and 0110),
- b. Receiving an indication of a security risk of one or more of the elements (See Figures 8 and 15, paragraph 0011),
- c. Receiving selection of an element (See Figure 15), and
- d. Transmitting a description of the security risk as it relates to the element selected based on hierarchical relationship and indication of security risk (See Figures 15 and 16, paragraph 0012).

9. With respect to Claim 2: See Figure 16 and paragraph 0106.

10. With respect to Claim 3: See Figures 15 and 47.

11. With respect to Claim 4: See Figures 15-16, 23, 24.

12. With respect to Claim 5: the description of the security risk comprising misappropriation of information is considered to be descriptive non-functional language. This information is not further used in the claims, and therefore is analogous to printed matter. It has been held (In re John Ngai and David Lin, CAFC, 5/13/04, 03-1524) that when printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the art in terms of patentability. The case also states that if we were to adopt Ngai's position, anyone could continue patenting a product indefinitely provided they add a new instruction sheet to the product. The description of the security risk comprising misappropriation is simply a form of

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printed matter (on in electronic form). Beverina discloses transmitting a security risk, what descriptive information about the security risk is transmitted is considered to be printed matter, and therefore not given patentable weight, therefore Beverina discloses Claim 5.

13. With respect to Claim 6: See Figure 23, paragraphs 0013 and 0096)
14. With respect to Claim 7: See Paragraphs 0174, 0175, and 0209-0222.
15. With respect to Claim 8: See Figures 21 and 40, paragraph 0085.
16. With respect to Claim 9: See Figures 15 and 19.
17. With respect to Claim 10: See Paragraph 0198.
18. With respect to Claim 11: Beverina discloses a computer implemented method for managing a security risk of a facility (See abstract), comprising the steps of:
 - a. Presenting a graphical user interface related to a facility (See Figures 8 and 41, paragraph 0070)
 - b. Displaying security issue related to a geographic area (See Figure 8),
 - c. Indicating one or more threats (See Figure 8 and 15)
 - d. Displaying a relative location of an ingress route of the hazards (paragraphs 0180, 0198, 0269, 0307, 0308, 0443, and 0444)
19. With respect to Claim 12: See Paragraphs 0008 and 0009.
20. With respect to Claim 13: See Figure 42, paragraph 0016 and 0106.
21. With respect to Claim 14: Beverina discloses a method for managing security risks (See abstract) which comprises the steps of:
 - a. Inputting an indication of a facility (See Figures 19, 27 and 28, paragraph 0078)

- b. Receiving an indication of one or more security risks (See Figure 15, paraphrase 0080).
- c. Inputting an indication of a subset of the facility, receiving information descriptive of the security risks of the subset and receiving an image of the subset of the facility (See Figures 6, 7, 19 and 27, paragraphs 0078-0080).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 17 and 18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Beverina.

23. Beverina, as disclosed above for Claim 1, discloses the use of a computerized method that sets a hierarchical relationship between elements, indicates the risks of the selected element and transmits those risks to a user along with counter measures (See abstract and all figures). However Beverina does not specifically recite the use of a digital signal embodied in a digital data stream comprising data relating to managing security risks. Beverina discloses in Figures 2, 6, 10, 12, 13, 23 and 24 and in paragraph 0014, the use of networks and plug-ins where data is transferred back and forth through different systems and databases and engines in order to access the security risk. The data that is being passed back and forth to processes and computers of the

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system must be some sort of signal, therefore it is inherent that the data passed is in the form of a digital data signal, and if it is not inherent in the network/plug-ins themselves that the data passed is a digital data signal, then it would have been obvious to one having ordinary skill in the art that the data being passed through the network and computers is being passed using a data digital signal due to the fact that it is old and well known in the art that when a network is set up digital cables are used to connect the computers together for the increased speed that digital cables provide.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lawrence et al. (2002/0138407) discloses a global risk management system, Milgramm et al. (2003/0163709) discloses the use of a building security system, Yadav-Ranjan (2004/0059592) discloses the use of a risk assessment scoring system, Sugimoto (US 2003/0093696) discloses the use of a risk assessment method and Fufido et al. (6,720,874) discloses the use of a security system and alarm on an entry way.

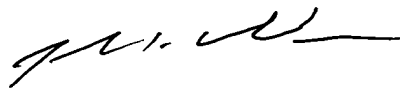
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamisue Webb


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